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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Mariah Media, Inc.

v.

Kevin J. Carnahan

Opposition No. 122,201
to application Serial No. 75/939,499
filed on March 9, 2000

Brian L. Heidelberger and Brian D. Fergemann of Winston & Strawn for Mariah Media, Inc.

Patrick I. Rea of Taylor, Messick & Tosti, P.C. for Kevin J. Carnahan

Before Cissel, Seeherman and Walters, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Mariah Media, Inc. has opposed the application of Kevin J. Carnahan to register GO OUTSIDE AND PLAY as a trademark for the following goods and services:

Publications, namely books, calendars,
brochures, guide books, instructional

guides and reference guides in the field of outdoor recreation (Class 16); and

Providing information services in the subject of outdoor recreation via a global computer network (Class 41).¹

As grounds for opposition opposer has alleged ownership of ten federal trademark registrations, including the marks OUTSIDE for recreational magazines and OUTSIDE ONLINE for interactive electronic information services regarding outdoor sports and recreation; and that because of the similarity of the parties' marks and the related nature of the "services,"² applicant's mark is likely to cause confusion or mistake or to deceive.

The parties stipulated that evidence could be submitted through affidavit. Opposer's evidence consists of the affidavit, with exhibits, of Anne Mollo-Christensen, opposer's vice president of business development, and includes evidence relating to opposer's business activities with respect to opposer's various "OUTSIDE" trademarks. Applicant's evidence consists of his affidavit, with exhibits; the exhibits include the

¹ Application Serial No. 75/939,499, filed March 9, 2000, and asserting a bona fide intention to use the mark in commerce.

² Although opposer used the term "services" in the notice of opposition, it is clear from the evidence submitted at trial, as well as the parties' briefs, that the claim of likelihood of confusion is based on an asserted relatedness between the

discovery deposition which opposer took of him, and the results of his searches of the Internet for the word "outside" for publications and Internet-based information services related to recreation.

The case has been fully briefed, but an oral hearing was not requested.

We begin with some matters of pleading and procedure. In its notice of opposition opposer pleaded ownership of ten trademark registrations. During its testimony period opposer made seven of these registrations of record by their introduction, with the affidavit of Ms. Mollo-Christensen, who testified that each of these registrations "is currently in force and owned by Mariah Media." Ms. Mollo-Christensen also testified to opposer's ownership of certain applications. We note that two of these applications have now issued as registrations, and because in its trial brief applicant specifically acknowledged opposer's ownership of registrations for two of these marks, we deem the pleadings to be amended to include a claim of likelihood of confusion with respect to Registration Nos. 2,539,895 and 2,546,325. In addition, although opposer did not provide any testimony as to the status and title of its

parties' goods as well, and we have treated the pleadings as

pleaded registration for OUTSIDE STORE, applicant acknowledged opposer's ownership of this registration is its brief.

In its brief, opposer asserts that it has a family of OUTSIDE marks. However, the allegation of a family of marks, and a claim of likelihood of confusion with such a family, was never made in the notice of opposition. In the last paragraph of Ms. Mollo-Christensen's thirteen-page affidavit, she states, as an introductory sentence to a paragraph regarding opposer's actions vis-à-vis third parties who attempt to use "OUTSIDE" trademarks, that "Mariah Media has spent considerable time, money and resources defending its family of "OUTSIDE" trademarks." This reference is insufficient to put applicant on notice that opposer is claiming a family of marks, nor is it sufficient for us to conclude that the issue of likelihood of confusion with opposer's asserted family of marks has been tried. Thus, we cannot deem the pleadings to be amended pursuant to Fed. R. Civ. P. 15(b). In any event, opposer has not proven a family of marks. The only evidence opposer points to in support of its claim that its marks are promoted as a family are exhibits 3

having been amended to include such a claim.

and 6 to the Mollo-Christensen affidavit.³ Exhibit 3 includes excerpts from some issues of OUTSIDE magazine. The excerpts of the magazines which issued in November and December 2001 show that, at the top of the page called Active Traveler (pages 145 and 157 in these issues) there is a small box containing the phrase "Check out Outside Online for all your travel planning needs. Go to outsidemag.com/destinations for the Active Travel Directory online, articles on travel, book suggestions and more." Not only is this minor reference insufficient to establish a family of OUTSIDE marks, but these magazines issued after the filing date of applicant's application, and therefore would not establish the existence of a family prior to applicant's constructive use date. Exhibit 6 suffers from the same infirmities. The small picture of the cover of the OUTSIDE magazine shown on the OUTSIDE ONLINE website is not sufficient to demonstrate that there is a family of OUTSIDE marks, and there is no evidence that these materials appeared on postings prior to March 2000 (the copyright dates which are shown in the submissions are 2001).

³ Opposer specified this evidence in its reply brief, in direct response to applicant's claim that opposer has not established a family of marks. See pp. 4-5.

Accordingly, we consider the issue before us to be whether there is a likelihood of confusion with the following registered marks:

OUTSIDE	Recreational magazine issued from time to time ⁴
OUTSIDE (lined for yellow and red)	Magazine in the field of outdoor sports, fitness and recreational activities ⁵
WOMEN OUTSIDE (WOMEN disclaimed)	Magazine in the field of outdoor sports, fitness and recreational activities ⁶
OUTSIDE RADIO NETWORK (RADIO NETWORK disclaimed)	Entertainment in the nature of an ongoing radio program in the field of outdoor sports, fitness and recreation ⁷
OUTSIDE ONLINE (ONLINE disclaimed)	Interactive electronic information services regarding outdoor sports and recreation ⁸
OUTSIDE ONLINE (ONLINE disclaimed)	Leasing access time to a computer database I the nature of a computer bulletin board in the field of outdoor sports and recreation ⁹
OUTSIDE STORE (STORE disclaimed)	Providing retail store services in the filed of outdoor sporting, recreational and leisure equipment, apparel, and accessories, with the

⁴ Registration No. 1,507,125, issued October 4, 1988; Section 8 affidavit accepted; Section 15 affidavit received.

⁵ Registration No. 2,025,585, issued December 24, 1996; Section 8 affidavit accepted; Section 15 affidavit received.

⁶ Registration No. 2,290,599, issued November 2, 1999.

⁷ Registration No. 2,261,533, issued July 13, 1999.

⁸ Registration No. 2,030,603, issued January 14, 1997; Section 8 affidavit accepted; Section 15 affidavit received.

⁹ Registration No. 2,012,332, issued October 29, 1996; Section 8 affidavit accepted; Section 15 affidavit received.

	exclusion of gardening tools ¹⁰
OUTSIDE TELEVISION (TELEVISION disclaimed)	Entertainment in the nature of on-going television programs in the field of outdoor sports, fitness and recreation; television programming services ¹¹
OUTSIDE BOOKS (BOOKS disclaimed)	Book imprint and publications, namely books relating to outdoor sports, travel and recreation ¹²
OUTSIDE	On-line retail store services on a global computer network featuring outdoor sporting equipment and apparel; online services on a global computer network, namely, providing for the purchase of transportation arrangements as part of adventure packages ¹³

Because the marks OUTSIDE for magazines and OUTSIDE ONLINE for electronic information services are the closest to applicant's mark and goods and services, we have focused our analysis of the issue of likelihood of confusion on these marks and goods/services.

According to Ms. Mollo-Christensen's affidavit (the only evidence submitted by opposer), opposer is a media company whose efforts are directed to outdoor travel and adventure services. It has published OUTSIDE magazine

¹⁰ Registration No. 2,022,426, issued December 10, 1996.

¹¹ Registration No. 2,304,468, issued December 28, 1999.

¹² Registration No. 2,539,895, issued February 19, 2002.

monthly since 1976. This magazine presents information about outdoor locations of interest, local outdoor events/activities and general outdoor activities such as running, rock climbing, skiing, sailing, professional sports and the arts. Since 1976 OUTSIDE magazine has contained an "Outside Magazine Active Traveler" Directory which lists local providers of outdoor sports and recreation services.

Opposer's magazine is read by men and women of all ages and physical abilities. It is sold through such retail outlets as bookstores, newsstands, grocery stores and outdoor specialty stores, as well as Internet retailers such as Amazon.com. It is also sold on a subscription basis. Ms. Mollo-Christensen stated that in 2001 annual sales of the magazine were in excess of \$30 million, and the magazine had a circulation of over 625,000, with total adult readership of 1,837,000.

From 1976 until January 2002, when Ms. Mollo-Christensen's affidavit was signed, opposer spent in excess of \$250 million on "the creation, development and nationwide promotion of its magazine" sold under the mark OUTSIDE. The advertising includes television, radio, print, Internet, point of sale and direct mail

¹³ Registration No. 2,546,325, issued March 12, 2002.

advertising, as well as promotional devices such as calendars.

Since January 1995 opposer has operated an Internet website called OUTSIDE ONLINE, located at www.outsidemag.com, which presents information about outdoor locations of interest, local outdoor events/activities and general outdoor activities. In 2001 products and services marketed through the website exceeded \$300,000 in sales, and viewership of the website that year was 150,000. Between 1995 and 2001 opposer spent in excess of \$1.5 million on "the creation, development and nationwide promotion of the marks OUTSIDE ONLINE and OUTSIDE in connection with the website." The marks OUTSIDE ONLINE and OUTSIDE have been used in television, radio, print, Internet, point of sale and direct mail advertising, and promotional devices such as calendars.

In addition to its use of the marks OUTSIDE and OUTSIDE ONLINE, opposer been involved with other "OUTSIDE" activities. For example, it has operated OUTSIDE TELEVISION since 1995. This is a television production company which provides television programming relating to outdoor sports, fitness and recreation. OUTSIDE TELEVISION programming is principally broadcast

via the Outdoor Life Network cable station. It also used the trademark OUTSIDE RADIO NETWORK from January 1998 until June 1999 for a syndicated weekly radio show, although opposer does not have current plans to resume the broadcasts. It also used the mark WOMEN OUTSIDE for a monthly magazine concerning women's outdoor sports which was published between 1998 and 1999, but it does not have current plans to publish the magazine again.

Opposer has also presented affidavit testimony about certain ventures that commenced after the filing of applicant's application. Since 2000 opposer has published a series of books entitled OUTSIDE ADVENTURE TRAVEL under its book imprint OUTSIDE BOOKS. These books are travel guides, anthologies and photography books which focus on outdoor sports and recreation equipment and activities. It also plans to develop a series of books under the OUTSIDE BOOKS imprint which focus on outdoor events and activities in particular cities. The first books in the series will include "Outside Urban Adventure Guide-New York."¹⁴ The mark OUTSIDE BOOKS itself was first used in November 2000.

¹⁴ Ms. Mollo-Christensen's affidavit states that "the first books in the series are tentatively scheduled to be offered for sale beginning Spring, 2001." ¶4(c). However, we note that her affidavit was signed on January 21, 2002, substantially after the intended Spring 2001 launch date. We are at a loss to

Opposer produces original television programming through its affiliate OUTSIDE TELEVISION, which opposer has operated since 1995. The programming relates to outdoor sports, fitness and recreation, and is principally broadcast via the Outdoor Life Network cable station.

Applicant plans to use the mark GO OUTSIDE AND PLAY for a series of recreational guidebooks and calendars, with each publication focused on a particular metropolitan area, and for information services via the Internet about recreational activities in particular metropolitan areas. He has not yet commenced use of the mark, although he has obtained a URL for his website, called www.gooutsideandplay.net, which he registered in early 2000. There is no content on that website, except for the repeated words "GO OUTSIDE AND PLAY." He also

understand why her affidavit refers to Spring 2001 as though it were a date in the future, and does not provide more accurate information as to the introduction of the books. (Opposer's brief states that the guides are scheduled to be in distribution in November 2002, but that assertion does not appear to be substantiated by the evidence of record.) Although this reference to Spring 2001 casts some doubt on the accuracy of her testimony in terms of how much she actually does know about the company's business affairs, because there are no obvious discrepancies regarding opposer's other activities, and applicant has not challenged the accuracy of the information, we have accepted such testimony, and have viewed the testimony relating to the publication of the books as referring to an indeterminate future event. In any event, the specifics of when these guides will be published has no impact on our decision.

testified that he chose the trademark because of childhood memories of his mother and other parents using the phrase as an instruction to their children.

Priority is not in issue in view of opposer's registrations for the various OUTSIDE marks, which are of record. **King Candy Company v. Eunice King's Kitchen, Inc.**, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, the evidence shows that opposer began using the marks OUTSIDE for magazines and OUTSIDE ONLINE for a website presenting information about outdoor locations and activities prior to the filing date of applicant's intent-to-use application.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

We turn first to the evidence regarding the fame of opposer's mark, since "fame of an opposer's mark or marks, if it exists, plays a 'dominant role in the process of balancing the *DuPont* factors'." **Bose Corp. v. QSC Audio Products, Inc.**, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002), quoting **Recot Inc. v. Becton**, 214 F.3d

1322, 54 USPQ2d 1894 (Fed. Cir. 2000). We disagree with opposer's assertion that, because applicant has not directly addressed in his brief opposer's arguments regarding the fame of its marks, applicant has conceded that opposer's marks are widely known, let alone famous. On the contrary, applicant has asserted that opposer has not presented any evidence which would imply any secondary meaning for any of opposer's marks, brief, p. 4, and that opposer's marks are weak. Brief, p. 9.¹⁵

Moreover, we find that opposer has not established that its marks OUTSIDE and OUTSIDE ONLINE are famous. Although opposer has used its mark OUTSIDE for a magazine for a substantial period of time (since 1976), the only sales information it has provided is its sales in the year 2001, when it had sales in excess of \$30 million, based on a circulation of 625,000. Ms. Mollo-Christensen testified that the adult readership of the magazine in that year was 1,837,000, although she did not explain how this determination was made.

¹⁵ We note that opposer need not submit evidence of secondary meaning for its marks. Because the marks were registered on the Principal Register without resort to the provisions of Section 2(f) of the Trademark Act, and because applicant did not counterclaim to cancel the registrations or, for that matter, assert that the marks were merely descriptive, the marks must be deemed to be inherently distinctive.

Thus, we do not know the amount of sales or circulation the magazine had in the years prior to 2001. Nor has opposer submitted any evidence as to the sales position of its magazine, such that we can determine whether \$30 million in sales, and a circulation of 625,000 would entitle OUTSIDE to be treated as a famous mark. It does not appear to us that these numbers are particularly large for a magazine that is "sold to, and read by, men and women of all ages and physical abilities," including "people with severe handicaps, people who live in the inner city and people of low income." Mollo-Christensen, ¶ 3(b). Nor has opposer provided sufficient information of its promotional activities for us to conclude that a significant number of additional people have been exposed to magazines sold under the OUTSIDE mark. Opposer has chosen to combine its promotional and advertising expenditures with its expenditures on the creation and development of its magazine. Mollo-Christensen, ¶3(f). Therefore, we cannot determine what portion of the \$250 million opposer has spent since 1976 is attributable to such development costs as writer's salaries, travel expenditures, obtaining financial backing, and the like.

There are similar problems with opposer's evidence of fame of OUTSIDE ONLINE for its Internet information services. Opposer has offered these services for a much shorter time, since 1995, and has chosen to combine, in Ms. Mollo-Christensen's testimony, its promotional costs in connection with the website with its costs of creation and development.

We also note that opposer has been rather general in its description of its promotional and advertising efforts. Thus, although opposer has stated that its OUTSIDE and OUTSIDE ONLINE marks have been used, inter alia, in television, radio, print, Internet and point of sale advertising, opposer has not presented examples of such advertising, or even indicated on which television stations or programs or which print materials its advertising has been featured. As a result, we cannot determine the impact opposer's advertising has had on the consuming public.

Although the factor of fame does not favor opposer, it is clear that a single DuPont factor may be dispositive. See **Kellogg Co. v. Pack'em Enterprises, Inc.**, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991), in which the Court held that the dissimilarity of the marks outweighed the other relevant DuPont factors, and was a

sufficient basis on which to find no likelihood of confusion. In this case, we find that the dissimilarity of the marks, and the weakness of the term OUTSIDE, outweigh the other DuPont factors, such as the relatedness/legal identity of the goods and services, legally identical channels of trade and classes of consumers, and the casual and/or impulse nature of the purchases, that favor opposer.

Obviously, the only element that the marks have in common is the word OUTSIDE, OUTSIDE being the entirety of opposer's mark for its magazine and the dominant element of the mark OUTSIDE ONLINE for its information provided over the Internet. OUTSIDE is obviously a highly suggestive term for a magazine and an Internet website that feature outdoor sports and recreation equipment and activities.¹⁶ Moreover, applicant has provided evidence

¹⁶ In its reply brief opposer states that applicant asserted that opposer's OUTSIDE marks are weak because they are suggestive of the content of opposer's publications, and then goes on to discuss that several of its registrations are incontestable and cannot be challenged on the ground of mere descriptiveness. We therefore think it important to make clear that there is a distinction between suggestive and merely descriptive marks, and our finding that OUTSIDE is highly suggestive for opposer's goods and services is neither a finding that the term is merely descriptive, nor is it an impermissible attack on the validity of opposer's marks, an attack which has not been made by applicant either. (As an aside, opposer should note that it has not submitted evidence that any of its registrations are incontestable, Ms. Mollo-Christensen testifying only that the registrations are "currently in force

of third-party use of various "OUTSIDE" marks for magazines, including "INSIDE OUTSIDE SOUTHWEST, OREGON OUTSIDE, OUTSIDE BOZEMAN, OUTSIDE HILTON HEAD, and for outdoor information sites on the Internet, including ARIZONA OUTSIDE, BE OUTSIDE IN NEW ENGLAND and GUIDE TO TEXAS OUTSIDE.¹⁷ Although applicant has not provided information as to the extent of the sales or distribution of the third-party OUTSIDE magazines or the length of time the websites have been in operation and the number of "hits" they have received, the third-party usage does serve to demonstrate the limited scope of protection to which the word OUTSIDE is entitled, and to show that consumers are able to distinguish among various OUTSIDE magazines and websites by the other words used in the marks.

and owned by [opposer]." However, the question of incontestability is not applicable to an opposition proceeding, since that provision applies to infringement actions brought under Section 32 of the Act, and defenses thereto.)

¹⁷ Opposer has criticized this evidence because "a search report does not constitute evidence of the existence of a registration or use of a mark." Brief, p. 7. However, the principle to which opposer refers is that a trademark search report prepared by a private company is not an appropriate method for making a trademark registration of record, and that, in any case, trademark registrations are not evidence of the use of the mark shown therein. In this case, however, applicant has testified that he conducted a search of the Internet for commercially available publications dealing with outdoor recreation. The results of such a search are admissible evidence.

In this environment, we find that consumers will not assume that there is an association or connection between the source of opposer's OUTSIDE magazines and OUTSIDE ONLINE Internet information services, and applicant's mark GO OUTSIDE AND PLAY for the same goods and services simply because both parties' marks contain the word OUTSIDE. On the contrary, we find that consumers will easily distinguish between the marks. The additional words in applicant's mark not only create an overall visual and phonetic difference, but the connotations of the marks are very different. Most consumers will find GO OUTSIDE AND PLAY to be a familiar reminder of a parent's instruction during their childhoods, a connotation that OUTSIDE per se and OUTSIDE ONLINE simply do not have. We also disagree with opposer's contention that OUTSIDE is the dominant element of applicant's mark. Opposer has provided no support for its view that consumers are likely to shorten GO OUTSIDE AND PLAY to GO OUTSIDE and then to retain only the word OUTSIDE in recalling the mark. Rather, because of the familiarity of the phrase, it is the phrase as a whole that will be recalled, and therefore we do not regard OUTSIDE to be the dominant element of the mark.

Decision: The opposition is dismissed.